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| 09/428,036 | 10/27/1999 | KEVIN H. NEWTON | D-1124 | 4122 |

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EXAMINER

MORGAN, ROBERT W

ART UNIT

PAPER NUMBER

3626

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/428,036

Applicant(s)

NEWTON ET AL.

Examiner

Robert W. Morgan

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-- Th MAILING DATE of this communication appears on the cover sheet with th correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 1, 10-14 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,587 to Ahlin et al.

As per claim 1, Ahlin et al. teaches an automated pharmaceutical management and dispensing system with a means for storing information concerning prescribed medical elements, including medications, for a plurality of patients at a health care facility; a vault storage assembly for storing and holding a plurality of packaged medical elements; and means for moving the medical elements in the receptacle bins into a medical-dispensing apparatus for dispensing to a particular patient. The medical-dispensing apparatus includes a means for dispensing prescribed medical elements into bin respectable in accordance with information from the information-storing means for delivery (see: column 3, lines 45 to column 4, lines 3 and Fig. 1). In addition, certain medical supplies such as syringes, sponges, clamps, etc., are generally obtained and included in the system (see: column 5, lines 18-26). Ahlin et al. also teaches that doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist using a ward-based computer, lap-top or internet computer device (see: column 6, lines 32-45).

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Moreover, Ahlin et al. teaches a dispensing system with a robot control computer which controls a multi-vault medication dispensing system with its own microprocessor control on board each vault assembly (see: column 6, lines 46-56 and Fig. 1).

Ahlin et al. fails to explicitly teach a data store and data representative of a plurality of holding locations for medical items in a medical item dispenser.

Since Ahlin et al. teaches storing information concerning prescribed medical elements and a robot control computer with its microprocessor control on board each vault assembly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the automated pharmaceutical management and dispensing system as taught by Ahlin et al. to include a data store and data representative of a plurality of holding locations for medical items in a medical item dispenser with the motivation of offering a fast automated system that provides a high degree of accuracy, as well as inventory control (see: Ahlin et al.: column 25, lines 52-55).

As per claim 10, Ahlin et al. teaches a monitor (47, Fig. 1) connected to pharmacy control computer (22, Fig. 12) near the robot dispenser 26, Fig. 1) for displaying entered information (see: column 7, lines 50-63).

As per claim 11, Ahlin et al. teaches that a doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist by a ward-based computer, lap-top or internet computer device (see: column 6, lines 32-45).

As per claim 12, Ahlin et al. teaches a automated pharmaceutical management and dispensing system with a means for storing information concerning prescribed medical elements, including medications, for a plurality of patients at a health care facility see: column 3, lines 45

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to column 4, lines 3 and Fig. 1). Ahlin et al. also teaches that doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist by a ward-based computer, lap-top or internet computer device (see: column 6, lines 32-45) as well as a monitor (47, Fig. 1) connected to pharmacy control computer (22, Fig. 12) for displaying entered information (see: column 7, lines 50-63).

As per claims 13 and 14, Ahlin et al. also teaches that doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist by a ward-based computer, lap-top or internet computer device (see: column 6, lines 32-45) as well as a monitor (47, Fig. 1) connected to pharmacy control computer (22, Fig. 1) for displaying entered information (see: column 7, lines 50-63). The Examiner considers a doctors' prescription entered into the pharmacy central computer (22, Fig. 1) and dispensed from the robot computer (26, Fig. 1) to contain information such as the physician name.

As per claim 26, Ahlin et al. teaches profile window (323E, Fig. 14F) that includes sub-files for various patient medical data such as allergy information and medication history. The allergy information is used during the drug utilization review (DUR) to determine if there is a conflict between the patient's allergy history and the prescribed pharmaceutical or any pharmaceutical in the patient's profile (see: column 15, lines 35-60).

As per claim 27, Ahlin et al. teaches the transferring of data between an RCD host computer and a remote RPH workstation over the Internet (573, Fig. 17) (see: column 19, lines 50-64).

3. Claims 2, 9 and 15-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,587 to Ahlin et al. in view U.S. Patent No. 5,797,515 to Liff et al.

As per claim 2, Ahlin et al. teaches a automated pharmaceutical management and dispensing system with a means for storing information concerning prescribed medical elements, including medications, for a plurality of patients at a health care facility; a vault storage assembly for storing and holding a plurality of packaged medical elements; and means for moving the medical elements in the receptacle bins into a medical-dispensing apparatus for dispensing to a particular patient. The medical-dispensing apparatus includes a means for dispensing prescribed medical elements into bin respectable in accordance with information from the information-storing means for delivery (see: column 3, lines 45 to column 4, lines 3 and Fig. 1).

Ahlin et al. fails to teach data representative of a benefit plan associated with the patient, and payment rules concerning payment for medical items associated with the benefit plan and further comprising the step of charging for the dispensed medical item in accordance with the payment rules.

Liff et al. teaches a drug dispensing system that uses an electronic third-party payor card for drug purchases at the doctor's office (see: column 4, lines 67 to column 5, lines 2). Liff et al. also teaches that during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: column 13, lines 12-42 and column 16, lines 40-52). The Examiner considers the step of verifying insurance and payment information a form of evaluating the rules and regulation associated with making a payment for a prescription.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the drug dispensing system as taught by Liff et al. within the automated pharmaceutical management and dispensing system as taught by Ahlin with the

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motivation of having a patient's insurance information readily available at the physician's office, thereby avoiding the inconvenience of taking a trip the pharmacy (see: Liff et al.: column 4, lines 62-64).

As per claim 9, Ahlin et al. teaches an automated pharmaceutical management and dispensing system with a means for storing information concerning prescribed medical elements, including medications, for a plurality of patients at a health care facility (see: column 3, lines 45 to column 4, lines 3 and Fig. 1). Ahlin et al. also teaches that doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist by a ward-based computer, lap-top or internet computer device (see: column 6, lines 32-45).

Ahlin et al. fails to teach storing and inputting data representative of a benefit plan associated with the patient. Ahlin et al. also fails to teach charging for the medical item in accordance with the payment rules associated with the benefit plan determined to be associated with the patient.

Liff et al. teaches a host computer (46, Fig. 1) using pharmacy software packages that provide standard administrative and accounting capabilities and support features of the dispensing system such as a document printer (60, Fig. 1), that generates documents containing instruction for the patient or the practitioner and a keyboard (50, Fig. 1) that inputs the commands of the user (see: column 5, lines 19-25, 58-63 and column 7, lines 24-37). Liff et al. also teaches during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: column 13, lines 12-42, column 16, lines 40-52 and Fig. 1).

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The motivation for combining the teaching of Ahlin et al. and Liff et al. are discussed in the rejection of claim 2, and are incorporated herein.

As per claim 15, Liff et al. teaches a document printer that prints instructions specific to a dispensed pharmaceutical for use by the patient or medical practitioner (see: column 2, lines 58-67).

As per claim 16, Ahlin et al. teaches an automated pharmaceutical management and dispensing system with a means for storing information concerning prescribed medical elements, including medications, for a plurality of patients at a health care facility. Ahlin et al. also teaches that doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist by a ward-based computer, lap-top or internet computer device (see: column 6, lines 32-45) and a document printer that prints instructions specific to a dispensed pharmaceutical for use by the patient or medical practitioner (see: column 2, lines 58-67 and column 5, lines 58-63).

As per claims 17 and 18, Liff et al. teaches the step of applying to the type medical item, indicia indicative of data included in the prescription data and prescription data including instruction for using the type medical item and the medical item includes indicia indicative of the instruction (see: column 5, lines 58-63).

As per claim 19, Liff et al. teaches the step of printing a prescription label, wherein the prescription label includes the indicia indicative of the data included in the prescription data, wherein in the applying step the label is applied in connection with the type medical item (see: column 5, lines 58-63).

As per claims 20 and 21, Ahlin et al. teaches applying the step of executing the prior to step (d), wherein the indicia indicative of data included in prescription data is applied to the type medical item to be dispensed in step (d) (see: column 3, lines 45 to column 4, lines 3 and Fig. 1).

As per claim 22, Liff et al. teaches a label printer coupled to the controller for printing a patient prescription label for attaching to a dispensed pharmaceutical package. The label printer is inhibited until the bar-code reader verifies that the proper dispensing of the pharmaceutical has occurred (see: column 2, lines 53-67).

As per claim 23, Ahlin et al. and Liff et al. teaches a automated pharmaceutical management and dispensing system with a means for storing information concerning prescribed medical elements, including medications, for a plurality of patients at a health care facility; a vault storage assembly for storing and holding a plurality of packaged medical elements; and means for moving the medical elements in the receptacle bins into a medical-dispensing apparatus for dispensing to a particular patient. The medical-dispensing apparatus includes a means for dispensing prescribed medical elements into bin respectable in accordance with information from the information-storing means for delivery (see: Ahlin et al. column 3, lines 45 to column 4, lines 3 and Fig. 1). Ahlin et al. and Liff et al. also teaches that doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist by a ward-based computer, lap-top or internet computer device (see: Ahlin et al. column 6, lines 32-45). Additionally, Ahlin et al. and Liff et al. teaches that a licensed user, for example, a doctor, pharmacist, nurse, or other medical practitioner using a keyboard (50, Fig. 1) enters a command to request dispensing of a particular package pharmaceutical variety (32, Fig. 1) for a particular patient (see: Liff et al. column 5, lines 19-25).

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4. Claims 3-8, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,219,587 to Ahlin et al. in view U.S. Patent No. 5,797,515 to Liff et al. in further view of Official Notice.

As per claim 3, Ahlin et al. and Liff et al. teaches a card reader (38, Fig. 1) mounted directly to or near the cabinet and connected to the host computer (46, Fig. 1), where the patient inserts a card (39, Fig. 1) in the card reader (38, Fig. 1) to automatically receive medicine from the cabinet (see: Liff et al.: column 5 lines 47-53 and Fig. 1).

Ahlin et al. and Liff et al. fail to teach a reading a credit or debit card with a card reading device adjacent the dispenser, wherein the card reading device is in operative connection with the computer, and the charging step includes charging an account associated with the credit or debit card.

The Examiner takes Official Notice that, in the medical industry, the use of cash, checks or credit cards are old and well-known methods of payment for patient health care. One of ordinary skill in the art would have found it obvious at the time the invention was made to include the charging of a customer's credit or debit card with the system as taught by the Ahlin et al. and Liff et al. with the motivation of providing a fast and beneficial way for customers to make purchase and payment for prescription medicine.

As per claims 4-6, Ahlin et al. and Liff et al. et al. teaches a drug dispensing system that uses an electronic third-party payor card for drug purchases at the doctor's office (see: Liff et al. column 4, lines 67 to column 5, lines 2). Ahlin et al. and Liff et al. also teaches that during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified

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to determine whether the insurer will pay for the prescription and if any co-payment is required (see: Liff et al. column 13, lines 12-42 and column 16, lines 40-52).

Ahlin et al. and Liff et al. fail to explicitly teach a charging step of charging the benefits provider, charging the co-pay amount and charging the benefits provider the benefit amount.

The Examiner takes Official Notice that, in the medical industry cash, checks or credit cards are old and well-known methods of payment for patient health care, for instance, a patient may have to pay a deductible to be seen by a their physician usually about \$10-15 dollars with a credit card and the patient's medical insurance company would pay for the remaining amount.

The motivation for combining the teaching of Ahlin et al. and Liff et al. are discussed in the rejection of claim 3, and are incorporated herein.

As per claims 7 and 8, Ahlin et al. and Liff et al. fail to explicitly teach inputting and outputting information representative of the co-payment amount and acceptance of the co-pay amount.

However, Ahlin et al. and Liff et al. teach a host computer (46, Fig. 1) using pharmacy software packages that provide standard administrative and accounting capabilities and support features of the dispensing system such as a document printer (60, Fig. 1), that generates documents containing instruction for the patient or the practitioner and a keyboard (50, Fig. 1) that inputs the commands of the user (see: Liff et al. column 5, lines 19-25, 58-63 and column 7, lines 24-37). Ahlin et al. and Liff et al. also teach during the claim adjudication step (286, Fig. 12) a patient's insurance information is automatically verified to determine whether the insurer will pay for the prescription and if any co-payment is required (see: Liff et al. column 13, lines 12-42, column 16, lines 40-52 and Fig. 1).

The motivation for combining the teaching of Ahlin et al. and Liff et al. are discussed in the rejection of claim 3, and are incorporated herein.

As per claim 24, Ahlin et al. and Liff et al. teaches that doctors' prescriptions are typically entered directly into a pharmacy central computer (22, Fig. 1) by a pharmacist by a ward-based computer, lap-top or internet computer device (see: Ahlin et al. column 6, lines 32-45). Ahlin et al. and Liff et al. also teaches that a licensed user, for example, a doctor, pharmacist, nurse, or other medical practitioner using a keyboard (50, Fig. 1) enters a command to request dispensing of a particular package pharmaceutical variety (32, Fig. 1) for a particular patient (see: Liff et al. column 5, lines 19-25).

Ahlin et al. and Liff et al. fail to teach contacting the patient corresponding to the data inputted in step (c) after failing to executing step (d).

The Examiner takes Official Notice that it is common in the medical field, for a patient or a physician to be contacted if the pharmacist in order to clarify any discrepancies or make any modification to the prescription does not verify prescription information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of contacting a patient to verify information with the system as taught by Ahlin et al. and Liff et al. with the motivation of gathering accurate and reliable patient information thereby ensuring that the patient receives the correct prescription.

As per claim 25, Ahlin et al. and Liff et al. teaches an automated pharmaceutical management and dispensing system with a means for storing information concerning prescribed medical elements, including medications, for a plurality of patients at a health care facility (see: Ahlin et al. column 3, lines 45 to column 4, lines 3 and Fig. 1). Ahlin et al. and Liff et al. also

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teaches the use of software modules to optimize the use of the dispensing system that include contacting a physician to report side effects or other information (see: Ahlin et al. column 10, lines 25-50).

Ahlin et al. and Liff et al. fail to explicitly teach contacting the physician responsive to the failing of step (d).

The Examiner takes Official Notice that it is common in the medical field, for a patient or a physician to be contacted if the pharmacist in order to clarify any discrepancies or make any modification to the prescription does not verify prescription information. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of contacting a patient to verify information with the system as taught by Ahlin et al. and Liff et al. with the motivation of gathering accurate and reliable patient information thereby ensuring that the patient receives the correct prescription.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In related art (6,202,923) Boyer et al. discloses a method and an automated pharmacy system to alleviate the problem of printing labels for prescription.

In related art (6,351,688) Nichols et al. teaches an item dispensing system with a plurality of item dispensers at different locations.

In related art (5,404,384) Colburn et al. provides an inventory monitoring apparatus capable of real-time counting of objects from a location whose inventory is to be monitored.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert W. Morgan whose telephone number is 703-605-4441. The examiner can normally be reached on 8:30 a.m. - 5:00 p.m. Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

RWM
rwm
June 28, 2002


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